

Serial #: 09/444,774

In reply to Office action mailed: November 17, 2004

Page 11 of 16

### Remarks/Arguments

Claims 70, 73-87, 90-104, and 107-115 are currently pending in the application. Claims 77, 94, and 110 have been amended to correct a typographical error such that the claim refers to the proper claim from which it depends. Claims 71, 72, 88, 89, 105, and 106 have been deleted by previous amendment. No new matter has been added to the application. For at least the reasons stated below, Applicant asserts that all claims are in condition for allowance.

#### 1. 35 U.S.C. § 103 Rejections

Claims 70, 73-87, 90-104, and 107-115 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art. Specifically, claims 70, 73-81, 87, 90-98, 104, and 107-111 were rejected as unpatentable over *Webber*, U.S. Patent No. 6,167,378 (hereinafter "*Webber*"), in view of *Whipple, et al.*, U.S. Patent No. 6,289,385 B1 (hereinafter "*Whipple*"); claims 82-84, 86, 99-101, 103, and 112-115 were rejected as unpatentable over *Webber* in view of *Whipple* and further in view of *Abgrall*, U.S. Patent No. 6,373,298 (hereinafter "*Abgrall*"); and claims 85 and 102 were rejected as unpatentable over *Weber* in view of *Whipple* in view of *Abgrall* and in view of *Gerace*, U.S. Patent No. 5,991,735. Applicant respectfully disagrees with such rejection because *Webber* and *Whipple* do not teach or suggest, alone or in combination, all elements of Independent claims 70, 87, and 104. In addition, *Webber* and *Whipple* fail to teach or suggest the claim limitations embodied in dependent claims 73, 90, and 107. For the reasons expressed, Applicant asserts that these claims are in condition for allowance, and the rejections pursuant to 35 U.S.C. § 103(a) should be withdrawn and a notice of allowance issued.

##### A. Independent Claims 70, 87, and 104

Independent claims 70, 87, and 104 present a method, system, and computer program by which a framework manager can provide installation management in a network-based supply chain framework between independent business entities that use the network-based supply chain. In the Office Action, it is asserted that *Webber* read in light of *Whipple* makes the present claims obvious modifications of the prior art. Applicant respectfully disagrees with this assessment and application of *Webber* and *Whipple*, as there is no apparent purpose for combining the two pieces of prior art, and *Webber* fails to disclose or suggest use of a collaborative planning *tool*.

Serial #: 09/444,774  
In reply to Office action mailed: November 17, 2004  
Page 12 of 16

Claims 70, 87, and 104 claim a method, system, and computer program that allows a "framework manager in a network-based supply chain framework between at least two independent business entities such as service providers, vendors, resellers, manufacturers and the like. . . to (a) receive information via the network including information relating to a service provided by a service provider from the service provider; (b) receive information via the network including information relating to manufacturer offerings by a manufacturer from the manufacturer; (c) use and evaluate the information provided by the service provider via the network and the manufacturer to match the service to the offerings, evaluating factors that include cost and service provider requirements; and (d) use the service and manufacturer offerings information to manage installations through the use of a collaborative planning tool which facilitates the transfer of the information received from the service provider and the information received from the manufacturer." Claim 70; *see also* claims 87 and 104. *Webber* read in light of *Whipple* fails teach or suggest all claim limitations of the claims as presented.

1. *Webber* fails to disclose use of a collaborative planning tool.

*Webber* individually fails to disclose, teach or suggest use of a collaborative planning tool. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974)). As part of claim 70, the framework manager uses a collaborative planning tool to facilitate information transfer. The phrase "collaborative planning tool" is interpreted with its ordinary meaning – a planning tool used to assist the working together between two separate entities. *See* MPEP § 2111.01 (citing *In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989)) ("[T]he words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification.") It is asserted that *Webber* discloses use of such a tool, but this assertion is unsupported by the citations provided, as *Webber* only discloses automated events occurring upon the initiation of one party. *See Webber* at col. 19, lines 9-26 (disclosing example of automated supply chain activity using pre-approved contracts); col. 3, lines 60-65 (failing to disclose any collaborative planning tool); col. 14, lines 48-54 (same); col. 6, lines 24-28 (discussing the provision of a toolkit to draft contracts for use in the invention, but failing to disclose or suggest how such a toolkit is a collaborative planning tool being that the automative environment, the subject of the invention, does not utilize a collaborative planning tool); col. 16, lines 18-40 (disclosing the drafting and linking of

Serial #: 09/444,774

In reply to Office action mailed: November 17, 2004

Page 13 of 16

preapproved contracts, but failing to teach or disclose how that assists in collaborative planning); col. 20, lines 10-15 (describing integration with other systems but failing to discuss collaborative planning between separate entities); Fig. 9 (disclosing separate entities transmissions to the central CAP system, although without transmission from the CAP to the separate entities); col. 6, lines 13-24 (introductory paragraph failing to disclose any planning tool); Fig. 2, item 260 (disclosing communications and activity platform element, but not demonstrating any tool by which it may operate); col. 14, lines 4-11 (disclosing only separate functions of the CAP, but not collaborative planning tool to facilitate planning between entities). The references cited do not disclose any separate tool used in the management of information between *two separate entities*, nor does *Webber* teach or suggest one because the automation does not assist the communication of information directly between entities.

2. There is no suggestion or motivation to combine *Webber* and *Whipple*.

*Webber* read in light of *Whipple* fails to demonstrate that the claims as presented are obvious. Establishment of *prima facie* obviousness requires that references when read in combination must teach or suggest all the claim limitations. MPEP § 2142 at ¶ 3. "The mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness . . . unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 at ¶ 9. In the present case, the combination of *Webber* and *Whipple* do not satisfy these premises.

The *Webber* and *Whipple* references individually do not suggest the desirability of their combination. *Webber* and *Whipple* fail to suggest such combination would be beneficial because of the orientation and purpose of the inventions disclosed. *Webber* discloses an invention intending to automate contract fulfillment via a supply chain framework, removing delay in the execution and negotiation of contracts by using pre-approved contracts stored in the system. See, e.g., *Webber* at Abstract, line 1-2. Unlike *Webber*, *Whipple* discloses an invention that establishes a collaborative workspace in which separate entities can work on data packets or programs that are part of the same larger entity. See *Whipple* at Abstract. The *Whipple* reference is only relied upon for the disclosure of a framework manager that controls the collaborative workspace. This collaborative workspace is allegedly managed by a framework manager to manage version control of information packets placed in the collaborative workspace. *Id.* Such collaborative

Serial #: 09/444,774  
In reply to Office action mailed: November 17, 2004  
Page 14 of 16

environment is not based on any intention to further automation; in fact, it teaches in the opposite direction.

There is no suggestion to combine the two inventions as an obvious iteration. Initially, the two inventions are directed at very different situations. Even assuming that *Webber* is applicable to the presently claimed invention, *Webber's* automation is not obviously improved through the addition of *Whipple*. Additionally, *Webber* requires no separate collaboration space or framework manager for its management.

For the foregoing reasons, Applicant asserts that the prior art cited does not make obvious the claims as presented. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection be withdrawn, and a notice of allowance be issued.

B. Outstanding Dependent Claims

Dependent claims 73-86, 90-103, and 107-115 were rejected as well under 35 U.S.C. § 103(a). "If an independent claim is nonobvious under 35 U.S.C. [§] 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Because independent claims 70, 87, and 104 are in condition for allowance, dependent claims 73-86, 90-103, and 107-115 are in condition for allowance, and the rejections of these dependent claims should be withdrawn and a notice of allowance issued.

C. Dependent Claims 73, 90, and 107

In addition to the arguments presented above, Applicant submits that dependent claims 73, 90, and 107 are allowable for additional reasons. Claims 73, 90, and 107 were rejected on the basis that *Webber* additionally discloses the limitation of a "framework manager using the network to facilitate milestone-based project planning between the matched service provider and the manufacturer." See Claim 73. Applicant respectfully disagrees with this characterization as *Webber* fails to teach or suggest the use of milestone-based project planning.

As discussed in previous remarks submitted, *Webber* discloses a method that automates a supply chain for goods between manufacturers, consumers, and other intermediate parties. See *Webber* at Fig. 4, col. 3, lines 37-38, col. 6, lines 13-17. The purpose of the *Webber* invention is to integrate contracts among the separate entities

Serial #: 09/444,774

In reply to Office action mailed: November 17, 2004

Page 15 of 16

participating in the supply chain such that fulfillment proceeds automatically with predetermined contracts. See *id.*, at Abstract, lines 9-12, col. 6, lines 47-51. *Webber*, however, fails to disclose, teach or suggest the facilitation on the part of the framework manager of milestone-based project planning used by the individual entities.

Citations provided in the Office Action that purport to demonstrate the obviousness of this claim limitation fail to so provide such support. Indeed, all citations are inapposite to providing such support because the citations do not provide the suggestion or teaching of use of milestone-based project planning. See col. 17, lines 24-31 (discussing automation of contract fulfillment based upon a specific time schedule, but failing to provide any disclosure or suggestion as to how automation along a time schedule amounts to facilitating use of milestone-based project planning with the network-using entities); col. 19, lines 9-26 (again discussing automation of contract fulfillment without reference or suggestion to planning that is milestone-based); col. 3, lines 60-65 (describing object and advantage of invention, but again failing to discuss planning, only simultaneous operation among several suppliers/sellers); and col. 14, lines 48-54 (in the context of the entire paragraph from lines 44-58, discussing encryption or security that is included in the communications link of the disclosed invention, but failing to disclose or teach or suggest use of milestone-based project planning or how planning fits within the invention disclosed). Such citations allegedly lend support to facilitating project planning used by the framework manager, but the plain language of the claim indicates this interpretation is improper; the claim clearly discloses that the planning is done between the two separate entities, and facilitated by the framework manager. Without adequate support for the assertion that *Webber* provides the additional disclosure of the limitations claimed in the present invention, rejection based upon *Webber* and *Whipple* is inappropriate, and the rejection based upon 35 U.S.C. § 103(a) should be withdrawn. The limitations of dependent claims 73, 90, and 107 provide allowable subject matter.


### 3. Conclusion

Applicant has demonstrated how all pending claims are allowable over the art of record and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7387. If any fees are due in connection

Serial #: 09/444,774  
In reply to Office action mailed: November 17, 2004  
Page 16 of 16

with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-334801).

Respectfully submitted,



Craig J. Lervick, Reg. No. 35,244  
Customer No. 29838

OPPENHEIMER WOLFF & DONNELLY LLP  
Plaza VII, Suite 3300  
45 South Seventh Street  
Minneapolis, MN 55402  
Phone: (612) 607-7387  
Fax: (612) 607-7100  
E-mail: CLervick@Oppenheimer.com